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10/043,888	01/10/2002	Jonas L. Steinman	I02.004	6273

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/043,888	STEINMAN ET AL.
	Examiner	Art Unit	
	Palani P. Rathinasamy	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 February 2007</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>10,13-15,20,22,23,28,29,32,34,35,37,38,41,43-45,56 and 57</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>10,13-15,20,22,23,28,29,32,34,35,37,38,41,43-45,56 and 57</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This is in response to Applicant's Amendment filed on February 9, 2007.

2.   Claims 1-5, 7, 8, and 25-27 have been withdrawn. Claims 6, 9, 11-12, 16-19, 21,

24, 30-31, 33, 36, 39-40, 42, and 46-55 have been cancelled. Claims 10, 14, 20, 22,

23, 28, 32, 37, and 41 have been amended.

3.   Claims 10, 13-15, 20, 22-23, 28-29, 32, 34, 35, 37-38, 41, 43-45, 56, and 57 are

pending.

Response to Amendment

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

5.   Claims, 10, 13-15, 20, 22-23, 28, 29, 32, 34, 35, 37, 38, 56 and 57, including

amended claims, are rejected as being unclear to the examiner. Regarding

independent claims 10, 22-23, 28, 32, and 37, applicant teaches of displaying a

advertisement on at "least one of a first window or Web page" followed by serving

another advertisement on at "least one of a second window or Web page." It is unclear

to the examiner if the applicant intends for this second advertisement to be displayed on

a new window or in the same Webpage as the first advertisement. Applicant is required

to amend claims to resolve this ambiguity. Claims 13-15, 20, 29, 34, 35, 38, 56 and 57

are likewise rejected as being dependent on an unclear independent claim.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7.   **Claims 10, 13, 14, 22-23, and 57, including amended claims, are rejected**

under 35 U.S.C. 102(b) as being anticipated by Marsh et al. (US 5,848,397). Marsh

et al. teaches of a method for continuously changing advertisements displayed in

a web browser.

8.   Regarding claims 10, 22 – 23, applicant teaches of displaying a small form and a

large form of an advertisement on a web-browser. Marsh et al. shows an example

where a small version of an advertisement is displayed on the top of a browser and the

full version is displayed underneath [Fig 4].

9.   Regarding claim 13, 14 and 57, applicant teaches of asking the user if they would

like to view the advertisement and then receiving information from the user if they want

to view the ad. Marsh et al. teaches of advertisements that the user "clicks to receive

additional information" [Summary of the Invention, col 4, lines 32-37]. Providing a

clickable advertisement is an indication of an opportunity to view. By clicking on the

advertisement, the user gives notice of desire to view. Regarding claim 14, applicant

teaches of "requesting confirmation" that the user viewed the advertisement. The user

clicking on the advertisement is confirmation that they viewed the advertisement.

Claim Rejections - 35 USC § 103

10.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
>
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
>
> the prior art are such that the subject matter as a whole would have been obvious at the time the
>
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
>
> Patentability shall not be negatived by the manner in which the invention was made.

11.   Claims 15, 20, 56, including amended claims, are rejected under 35 U.S.C.

103(a) as being unpatentable over Marsh et al. (US 5,848,397).

12.   Regarding claim 15, 56, applicant teaches that the confirmation is displayed for a

fixed period of time. Marsh et al. does not explicitly teach of displaying for a fixed period

of time. However, Marsh et al. teaches that it is common for advertisements and

windows being shown for a "certain period of time" [Background of the Invention, col 2,

lines 22-34]. It would have been obvious to one skilled in the art, at the time of the

invention, to use Marsh et al.'s advertisements with a fixed display time. One would

have been motivated to do so in order to have a more "sophisticated system" whereby

the window stays on the user screen before being changed or closed. [Col 2, Line 30]

13.   Regarding claim 20, applicant teaches that the advertisement is "scrolled".

Marsh et al. does not explicitly teach of scrolling. OFFICIAL NOTICE is taken that a

browser window being scrolled is an option that is available to the user to which the

advertisement is displayed. It would have been obvious for a user to scroll

advertisements displayed in Marsh et al.'s system. One would have been motivated to do so in order to see the entire advertisement if the screen size was too small.

14.   **Claims 28, 29, 32, 34, 35, 37, 38, 41, 43-45, including amended claims, are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 5,848,397) in view of JAVA SCRIPT programming ("Java Script", Ready, 1996 New Riders Publishing). JAVA SCRIPT teaches coding methods for creating interactive web sites and is a standard method for creating advertisements in web domains.**

15.   Regarding claims 28, 29, 32, 34, 37, 38, 41 and 43, applicant teaches of displaying advertisements where the first advertisement is not resizable by the viewer. Marsh et al. does not explicitly teach of displaying advertisements where the first advertisement is not resizable. JAVA SCRIPT is a standard method for creating interactive web pages that display, amongst other things, advertisements (see figures on page 33). In JAVA SCRIPT coding, the switch "resizable" controls "whether the window can be resized" [JAVA SCRIPT, page 32]. Therefore it would have been obvious to one skilled in the art to display Marsh et al.'s advertisements using JAVA SCRIPT and prevent the advertisement window from being resized. One would have been motivated to do so in order to "[define] an exact-sized window for galleries, control pads and other purposes." [JAVA SCRIPT, page 32].

16.   Regarding claim 43, applicant teaches that the window has a "fixed size". A window that is not resizable is therefore fixed in size.

17.   Regarding claims 28, 32, 37 and 41, applicant teaches that the first

advertisement is not viewable because it is covered by the second advertisement.

Marsh et al. does not explicitly teach of covering one window with another. JAVA

SCRIPT gives an example of an advertisement that prevents another advertisement by

being on top [Figure 2.10, pg 33]. A screen that opens up over another screen (such as

a pop-up) is in its nature covering up the first screen. As show in Figure 2.10, the

secondary screen is opened up over the primary screen. Therefore, it would have been

obvious to one skilled in the art to display Marsh et al.'s advertisements using JAVA

SCRIPT such that one advertisement was not visible. One would have been motivated

to open a new window with the advertisement so that the ad is more prominently

displayed.

18.   Regarding claim 35, 44, 45, applicant teaches that the advertisement is displayed

full screen when it is displayed. Marsh et al. gives an example of browser windows (Fig

4), but does not explicitly teach of full screen. In JAVA SCRIPT coding, the variable

"width" and "height" control the size the window as it is displayed [JAVA SCRIPT, page

32]. The book also teaches of how to display windows that are in "full screen" mode

[JAVA SCRIPT, page 33]. Therefore it would have been obvious to one skilled in the art

to display the advertisement using JAVA SCRIPT and make the advertisement window

full screen. One would have been motivated to do so in order to properly display to the

user web pages with large amounts of content.

Response to Arguments

19.   Applicant arguments filed February 9, 2007, with respect to the rejection under

35 U.S.C. § 112, have been fully considered but are not persuasive.

20.   Examiner stated in previous office action that the claims were unclear as to "if the

applicant intends for [the] second advertisement to be displayed in a new window or in

the same window as the first advertisement." Examiner rejected the claims as being

unclear because it was not stated whether this was done in a new window or the same

window. Applicant amended the rejected claims. Applicant argues (on page 15) that

"as presently claimed in claims 10, 22 and 23, each of a brand component, small form

of an advertisement and a large form of an advertisement is different windows or web

pages."

However, Examiner further notes that it is the Applicant's claims as stated in the

Applicant's claims that are being rejected with the prior art. Also, although the claims

are interpreted in light of the specification, limitations from the specification are not read

into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir.

1993). And, Examiner notes that claims are given their broadest reasonable

construction. See In re Hyatt, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

Because claims are given their broadest reasonable construction, Examiner

respectfully disagrees that the amendments overcomes the rejection. In claim 10, for

example, applicant amended the claim to read "serving a brand component on at least

one of a first window or Web page; serving a small form of an advertisement on at least

one of a <u>second</u> window or Web page". In this case, when applicant claims the advertisement being displayed on "at least one of a <u>first</u> window or Web page"; the "or" allows for two different ways to read the claim. In the first situation, it can be read as the advertisements being displayed in a "first window", "second window", etc. In the second situation it can be read as advertisements being displayed in a single "Web page"; irregardless of it being in different "windows".

Additionally the difference between a window and a Web page is important to the scope of the Invention. A "window" is part of an Internet browser, which is local to the end user. Having multiple "windows" is analogous to multiple versions of the local software running. A web page is completely different because the software remains on the server (away from the user). Additionally, multiple web pages does not mean multiple windows. For example, when viewing web pages in a Pane form, users can view multiple web pages in the same window. Therefore, applicant's amended claims do not overcome this rejection.

If applicant is claiming different and separate windows (as argued on page 15), Examiner recommends removing the "or Web page" portion of the claim.

21.   Applicant's arguments filed on February 9, 2007, with respect to the rejection under 35 U.S.C. § 101, have been fully considered and are persuasive. The rejection of claim 23 has been withdrawn.

22.   Applicant arguments filed on February 9, 2007, with respect to the rejection

under 35 U.S.C. §§ 102 and 103, have been fully considered but are not persuasive.

23.   Claims 10, 13-15, 20, 22-23 and 56-57: Applicant argues that Marsh does not

teach what is currently claimed; that is displaying advertisements in separate or different

windows or web pages. However, as stated above in ¶ 20, as currently presented, the

applicant does not properly claim this.

24.   Claims 28, 29, 34, 35, 38, 43-45, 56 and 57: Applicant argues that although Java

Script shows a window displayed over an original window; a portion of the original web

page is still visible. Applicant does not claim that the webpage is entirely not viewable

to the viewer. Applicant merely claims that the web page is "not viewable." Likewise,

Java Script shows an example of a second window that makes the first window "not

viewable." Furthermore, JAVA SCRIPT's one example is not a limitation to all the

examples that are possible. Java Script teaches of secondary or pop-up windows that

open a new window over the first window. A secondary or pop-up window by definition

is a window that opens over the first window. Therefore, the idea of one window

covering another window is inherent.

25.   Applicant argues that although Java Script teaches that the size of the pop-up

window is also controllable, one would not have been motivated to have a second

window such that the first one is not viewable. Examiner respectfully disagrees.

Because secondary or pop-up windows by definition are ones that cover another

window, it is inherent that this covers the gambit of small windows to large windows. It

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Palani P. Rathinasamy whose telephone number is (571) 272-5906. The examiner can normally be reached on M-F 8:30-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PPR

ARTHUR DURAN
PRIMARY EXAMINER